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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/840,216	Applicant(s) PARKER ET AL.	
	Examiner Susanna M. Diaz	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 21, 2006 has been entered.

Claims 1, 2, 7, 8, 14, 15-17, and 20-22 have been amended.

Claims 1-9 and 12-22 are presented for examination.

Response to Amendment

2. The previously pending rejections under 35 U.S.C. §§ 101 and 112, 1st and 2nd paragraphs are withdrawn in response to Applicant's claim amendments and arguments.

Response to Arguments

3. Applicant's arguments filed June 21, 2006 have been fully considered but they are not persuasive.

Applicant argues the following:

As the Examiner correctly notes, Barton teaches a spreadsheet (Figure 4) that associates the responsible persons with the processes. However, neither the spreadsheet nor Barton's disclosure addresses elements

that are subject to the processes. The portions of the spreadsheet to which the Examiner equates the elements of the present invention are actually just further descriptions of the processes. For example, the Examiner claimed that the "infrastructure" listed in Figure 4 is an element that is subject to the processes of "leadership," "communication," "resources," and "discipline & enforcement." However, Barton specifically defines "infrastructure" (as well as the other headings listed in the left column of the spreadsheet of Figure 4) as compliance assessment areas 102, which are areas of a business that are being reviewed for compliance. Such "areas" are simply categories under which the processes fall, and are *not* elements that are used to complete the process. Thus, Barton is a simple one-to-one correlation between actors and processes. There is no teaching whatsoever, of elements (e.g., the nouns subject to the processes -- such as telephones or computers in an IT outsourcing). (Pages 15-16 of Applicant's response)

The Examiner respectfully disagrees. As stated in the art rejection, the Examiner submits that Fig. 4 and ¶¶ 39, 46-50 of Barton address this limitation. For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" may be interpreted as actors associated with the "Infrastructure" element and related processes. As a matter of fact, Applicant admits that Barton's spreadsheet (Fig. 4) associates responsible persons with the processes (page 15 of Applicant's response). For example, the fact that Fig. 4 of Barton graphs relationships among an actor, process, and element is indicative of a display depicting an "association" among the recited actor, process, and element. Additionally, since the "Exec. Staff", "HR", "Legal", and "Sales" refer to potential interviewees for assessing compliance in various areas of a business (¶ 62), it is understood that these actors are

somehow responsible for the respective area(s), which relate to the recited process and element, for which they may potentially be interviewed. While Applicant argues that “the portions of the spreadsheet to which the Examiner equates the elements of the present invention are actually just further descriptions of the processes” (page 15 of Applicant’s response), the claimed invention describes a process and an “element subject to the process.” The claim language does not preclude the element from being an aspect of the process itself. Therefore, Barton’s “Infrastructure” element is subject to the processes of “Leadership...”, “Communication...”, “Resources”, and “Discipline & Enforcement” just as recited in the claimed invention.

Furthermore, the specific types of processes, elements, and actors that may be inputted by a user do not affect the recited structure or functionality. As far as the graphing apparatus is concerned, no matter what type of data is inputted for a process, element, and actor, a similar graph is generated. The graphing apparatus does no processing beyond placing each piece of entered data into a specified area of the graph, based on how a human user enters data. In other words, in place of a specific process, element, and actor, a human user could literally enter the words “apple,” “banana,” and “orange” and the graphing apparatus would display a matrix showing the “apple,” “banana,” and “orange” in the same respective places compared to where the process, element, and actor would have been shown on the matrix. These differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention

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over the prior art. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106.

As per claims 8, 9, 13, 14, 16, and 20-22, Applicant does not argue the statements of Official Notice *per se*. Instead, Applicant argues that the Official Notice statements do not fully address the claim limitations. Applicant then states that Barton does not fully address the claim limitations and therefore there is no motivation to combine the teachings. However, Applicant does not address the combined teachings as a whole. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In conclusion, Applicant's arguments are non-persuasive.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites the step of "displaying, along the value chain, interactions between the organization and the supplier." It is not clear which interactions are displayed. The step of "receiving, from the user, input assigning actors for each process and its element" implies that interactions are defined; however, the actors are recited as either being the organization, the supplier for the organization, or a third party to the organization and the supplier. If the actors are selected from the organization, then there are no defined interactions between the organization and the supplier; therefore, there are no such interactions to display (as recited in the last step of claim 20). Claims 21-22 depend from claim 20 and, therefore, inherit the same rejection under 35 U.S.C. § 112, 2nd paragraph.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7 and 12 are rejected under 35 U.S.C. 102(a), (e) as being anticipated by Barton et al. (US 2002/0059093).

Barton discloses a method for illustrating an operation of an organization comprising:

[Claim 1] receiving, from a user, input defining the operation in the form of a value chain, the value chain containing a plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

receiving, from the user, input defining, for each process of the value chain an element that is subject to the process (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

receiving, from a user, input defining, for each process and its element, an actor that is responsible for completing the process with the element (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement."

"Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes); and

displaying on a single display, for each process of the value chain, an association between the process, its element subject to the process, and the actor responsible for completing the process with the element (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

[Claim 2] wherein displaying the association comprises plotting the value chain on a matrix (Fig. 4),

mapping a plurality of elements against the value chain on the matrix (Fig. 4),
indicating the actor of the associated process and element at an intersection on the matrix corresponding to the associated process and element (Fig. 4); and

displaying the matrix on a computer user interface (Fig. 4; ¶¶ 47-50);

[Claim 3] wherein the plurality of elements are grouped by class, business unit, and geography of the organization (Fig. 4 indicates that the elements, such as "Infrastructure", fall under a given class, e.g., "Compliance Assessment Areas"; Figs. 6 and 7 specify a business/company location, i.e., geography, corresponding to the elements);

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[Claim 4] wherein the class defines commonalities among a group of elements (Fig. 4 indicates that the elements, such as "Infrastructure", are common to a given class, e.g., "Compliance Assessment Areas");

[Claim 5] wherein the operation comprises an information technology operation, and wherein the element comprises one of a client, a server, an enabler, and an application (Figs. 4, 6, 7, 12, 13; ¶¶ 62, 66-69 -- Data from the questionnaire metrics chart and resulting compliance risk assessment is used to generate the quality function deployment (QFD) matrix. Therefore, the elements from Fig. 4 are linked to, or comprise, related IT applications, including "Information Systems" (Fig. 12) and "30.13 Product Development" and "Y2K Physical Product Upgrades" (Fig. 13));

[Claim 6] wherein the actor of the associated process and element comprises an actor responsible for furnishing the associated process and element (Fig. 4; ¶¶ 60-62 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors responsible for furnishing the associated process and element);

[Claim 7] wherein the actor comprises one of the organization, a supplier for the organization, and a third party to the organization and the supplier (Fig. 4; ¶¶ 60-62 --- Actors within the organization become owners of certain elements and processes);

[Claim 12] wherein the process is defined according to an industry standard (Fig. 4; ¶¶ 70, 85-91 -- The various elements are assessed in relation to compliance risks based on such areas as regulatory requirements (¶ 70), i.e., industry standards).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8, 9, and 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton et al. (US 2002/0059093), as applied to claims 1, 6, and 8 above.

[Claim 8] Barton does not expressly teach that the actor is the supplier, and wherein the method further comprises including the single display as part of a contract between the organization and the supplier for the supplier's furnishing of the associated process and element; however, the specific types of processes, elements, and actors that may be inputted by a user do not affect the recited structure or functionality. As far as the graphing apparatus is concerned, no matter what type of data is inputted for a process, element, and actor, a similar graph is generated. The graphing apparatus does no processing beyond placing each piece of entered data into a specified area of the graph, based on how a human user enters data. In other words, in place of a specific process, element, and actor, a human user could literally enter the words "apple," "banana," and "orange" and the graphing apparatus would display a matrix showing the "apple," "banana," and "orange" in the same respective places compared to where the process, element, and actor would have been shown on the matrix. These differences

are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Nevertheless, Official Notice is taken that it is old and well-known in the art of contract management for an organization to alert suppliers to the processes and elements thereof for which the organization is making them responsible. This practice helps to ensure a meeting of the minds so that contract terms are clearly set forth and more likely fulfilled by all parties involved. Barton discloses that a contract is developed between the organization and the outsourcer, as implied by the fact that the business analyzes its outsourcing (§ 69) and supplier agreements (§ 70); therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Barton such that the actor is the supplier, and wherein the method further comprises including the single display as part of a contract between the organization and the supplier for the supplier's furnishing of the associated process and element in order to facilitate a meeting of the minds between Barton's organization and contracted suppliers so that contract terms are clearly set forth and more likely fulfilled by all parties involved.

[Claim 9] Barton does not specify whether or not the evaluated business happens to be a company participating in a merger; however, Barton does perform business risk evaluations (§§ 69-70). Furthermore, Official Notice is taken that it is old and well-known in the art of merger planning for companies involved in the merger to consider various risk factors of each business when ultimately deciding to complete the merger or not. This assessment provides each business with a more realistic understanding of the pros and cons involved with the merger. Since Barton lays out groundwork for evaluating business risks, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to market Barton's invention to companies participating in a merger in order to expand Barton's customer base, thereby increasing Barton's likelihood to generate profit. It should also be noted that the fact that the "actor comprises one of a first company participating in a merger and a second company participating in the merger" does not affect the structure or functionality recited in the claimed invention; therefore, the patentable weight merited by such a limitation is questionable.

[Claim 13] In order to evaluate the various compliance assessment areas and related business risks and assign processes and elements to owners, or actors (as disclosed in Figs. 4, 12, 13; §§ 60-70), users of Barton's invention must at some level perform the steps of relating, developing, contacting, fulfilling, operating, advising, and managing. While Barton does not expressly define these steps as processes that are mapped out against related elements, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to utilize these specific

process labels (i.e., relate, develop, contact, fulfill, operate, advise, and manage) since Barton's users effectively perform these processes, thereby allowing Barton's invention to more comprehensively address processes specific to various types of organizations.

Barton discloses a method for illustrating a scope of an outsourcing comprising:

[Claim 14] receiving, from a user, input defining a value chain containing a plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

receiving, from the user, input defining a collection of elements, wherein the collection of elements is subject to the plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

receiving, from the user, input defining, for each process of the value chain, an element of the collection of elements that is subject to the process (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

receiving, from the user, input defining, for each process and its element, an actor that furnishes the process and its element (Figs. 4, 6, 7, 11, 12, 13, 17; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

[Claim 15] wherein displaying comprises mapping the plurality of processes against the collection of elements in a matrix, listing the actor at an intersection of the associated process and element within the matrix, and displaying the populated matrix (Fig. 4);

[Claim 17] wherein the process comprises a service measure, and the method further comprises displaying an association between a service level and the associated process and element (Fig. 4; ¶¶ 70, 85-91 -- The various elements are assessed in relation to compliance risks based on such areas as supplier agreements (¶ 70), i.e., expected service levels);

[Claim 19] wherein the plurality of processes comprises one of information technology functions, human resource functions, finance and accounting functions, procurement functions, call center functions, back-office functions, and mid-office functions (Figs. 4, 6, 7, 12, 13; ¶¶ 62, 66-69 -- Data from the questionnaire metrics chart and resulting compliance risk assessment is used to generate the quality function deployment (QFD) matrix. Therefore, the elements from Fig. 4 are linked to, or comprise, related IT applications, including "Information Systems" (Fig. 12) and "30.13

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Product Development” and “Y2K Physical Product Upgrades” (Fig. 13). ¶¶ 69-70 discusses various finance and accounting and procurement functions).

Regarding claims 14 and 16, Barton does not expressly teach that the actor is the supplier, and wherein the method further comprises including the single display as part of a contract between the organization and the supplier for the supplier's furnishing of the associated process and element; however, the specific types of processes, elements, and actors that may be inputted by a user do not affect the recited structure or functionality. As far as the graphing apparatus is concerned, no matter what type of data is inputted for a process, element, and actor, a similar graph is generated. The graphing apparatus does no processing beyond placing each piece of entered data into a specified area of the graph, based on how a human user enters data. In other words, in place of a specific process, element, and actor, a human user could literally enter the words “apple,” “banana,” and “orange” and the graphing apparatus would display a matrix showing the “apple,” “banana,” and “orange” in the same respective places compared to where the process, element, and actor would have been shown on the matrix. These differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish

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the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Nevertheless, Official Notice is taken that it is old and well-known in the art of contract management for an organization to alert suppliers to the processes and elements thereof for which the organization is making them responsible. This practice helps to ensure a meeting of the minds so that contract terms are clearly set forth and more likely fulfilled by all parties involved. Barton discloses that a contract is developed between the organization and the outsourcer, as implied by the fact that the business analyzes its outsourcing (§ 69) and supplier agreements (§ 70); therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Barton such that the actor is the supplier, and wherein the method further comprises including the single display as part of a contract between the organization and the supplier for the supplier's furnishing of the associated process and element in order to facilitate a meeting of the minds between Barton's organization and contracted suppliers so that contract terms are clearly set forth and more likely fulfilled by all parties involved.

[Claim 18] Barton discloses the step of associating a cost with associated process and element and displaying the associated process and element on the computer user interface (Fig. 4; §§ 70, 85-91 -- The various elements are assessed in relation to compliance risks based on such areas as carrying cost, financial controls, and expense approvals (§§ 69-70), i.e., cost for furnishing the associated process and element);

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however, Barton does not expressly teach that the cost is displayed on the computer user interface. The Examiner submits that it is old and well-known in the art that displaying multiple factors of an analysis on a user interface facilitates quick and efficient understanding of the relationships among the various factors, thereby allowing a user to more comprehensively glean the implications of such relationships. Since Barton teaches the display of various processes and elements and Barton discloses that cost contributes to the business risk evaluation, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Barton to display an associated cost along with the process and element in order to facilitate a quick and efficient understanding of the relationships among the various factors, thereby allowing a user to more comprehensively glean the implications of such relationships.

Barton discloses a method for illustrating interactions between an organization and an outsourcer (i.e., supplier of services) participating in an outsourcing comprising: [Claim 20] receiving, from a user, input defining a value chain containing a plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

receiving, from the user, input defining a collection of elements, wherein the collection of elements is subject to the plurality of processes (Fig. 4; ¶¶ 39, 46-50 -- For

example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

displaying, for each process, the element subject to the process (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

receiving, from the user, input assigning actors for each process and its element, wherein the actors are either the organization, the supplier for the organization, or a third party to the organization and the supplier (Fig. 4; ¶¶ 60-62 --- Actors within the organization become owners of certain elements and processes);

displaying, for each process, an actor responsible for completing the process with the process's element (Fig. 4; ¶¶ 39, 46-50 -- For example, "Infrastructure" is an element that is subject to the processes of "Leadership...", "Communication...", "Resources", and "Discipline & Enforcement." "Exec. Staff", "HR", "Legal", and "Sales" are actors associated with the "Infrastructure" element and related processes);

[Claim 22] mapping the plurality of processes against the collection of elements in a matrix (Figs. 4, 12, 13),

listing the actors at intersections of processes and elements in the matrix (Fig. 4),
displaying the matrix (Figs. 4, 12, 13), and

wherein the interactions model comprise process maps indicating a swim-lane boundary across which the interactions occur (Figs. 4, 12, 13).

Regarding claims 20 and 21, Barton does not expressly teach displaying, along the value chain, interactions between the organization and the supplier (claim 20), wherein the interactions define a sequence by which to complete the plurality of processes and information that is to be passed between the organization and the supplier (claim 21); however, the specific types of processes, elements, and actors that may be inputted by a user do not affect the recited structure or functionality. As far as the graphing apparatus is concerned, no matter what type of data is inputted for a process, element, and actor, a similar graph is generated. The graphing apparatus does no processing beyond placing each piece of entered data into a specified area of the graph, based on how a human user enters data. In other words, in place of a specific process, element, and actor, a human user could literally enter the words "apple," "banana," and "orange" and the graphing apparatus would display a matrix showing the "apple," "banana," and "orange" in the same respective places compared to where the process, element, and actor would have been shown on the matrix. These differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the

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same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Nevertheless, Official Notice is taken that it is old and well-known in the art of contract management for an organization to alert suppliers to the processes and elements thereof for which the organization in making them responsible. This practice helps to ensure a meeting of the minds so that contract terms are clearly set forth and more likely fulfilled by all parties involved.

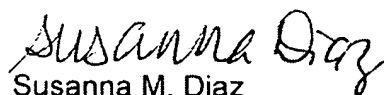
Barton discloses that a contract is developed between the organization and the outsourcer, as implied by the fact that the business analyzes its outsourcing (§ 69) and supplier agreements (§ 70); therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Barton to incorporate the step of displaying, along the value chain, interactions between the organization and the supplier (claim 20), wherein the interactions define a sequence by which to complete the plurality of processes and information that is to be passed between the organization and the supplier (claim 21) in order to facilitate a meeting of the minds between Barton's organization and contracted suppliers so that contract terms are clearly set forth and more likely fulfilled by all parties involved.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Susanna M. Diaz
Primary Examiner
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September 1, 2006